

Patent Application Serial No. 10/759,638**REMARKS****I. Specification**

Claims 1-13 were presented for examination by Applicant's filing of a nonprovisional application on January 16, 2004. The claims have been examined and they stand rejected under 35 U.S.C. 102(e) as being anticipated by Murrene et al (US Pub No 2003/0110085).

Applicant has amended claims 1, 6, 12 and 13. Reconsideration is now respectfully requested.

II. Claim Rejections - 35 USC §102(e).**Requirements for Prima Facie Anticipation**

A general definition of *prima facie* unpatentability is provided at 37 C.F.R. §1.56(b)(2)(ii):

A *prima facie* case of unpatentability is established when the information *compels a conclusion* that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. (*emphasis added*)

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundscriber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), adopted, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984). Thus, to anticipate the applicants' claims, the reference cited by the Examiner must disclose each element recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the

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invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the applicants need only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i.e.*, show that the reference cited by the Examiner fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

Murren et al.

The Examiner rejected claims 1-13 under 35 U.S.C. §102(e) as being anticipated by Murren et al.

Examiner states that the published Murran application discloses maintaining synchronization of information published to multiple subscribers over multicast communication over a data network citing to coordination between the tracking component (106) and publishing component (110). Applicant respectfully disagrees that Murren et al teaches multicasting of information.

Claim 20 has been amended to more clearly identify that use of a multicast communications transport layer facilitates synchronization. The claims read as follows:

1. A method of synchronizing multi-site print ready document libraries, comprising:

publishing document library subject availability via multicast communication over a data network using a multicast communication transport layer;

receiving subscriptions for document library subjects via point-to-point data communication over the data network from remote subscribers at individual sites; and

instantaneously, at time of repository change, synchronizing data representative of the document with remote subscribers at individual sites over the data network using a multicast communication transport layer.

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6. A method of synchronizing multi-site print ready document libraries, comprising:
publishing document library subject availability via multicast communication over a data network using a multicast communication transport layer; and
receiving subscriptions for document library subjects over the data network via point-to-point data communication from remote subscribers at individual sites.
12. A system for multi-site print ready document library synchronization via multicast, comprising:
at least one server having access to a data network supporting point-to-point data communication and also supporting multicasting over a multicast communication transport layer;
at least one database containing documents associated with a print ready document library and the print ready document library; and
software contained in at least one of server, said software for: managing the publication of print ready document library information to multiple subscribers over the data network using a multicast communication transport layer, accepting document library subscription from the multiple subscribers point-to-point data communication, and synchronization of print ready document library and documents associated with the library with the multiple subscribers from the database through the server and the network point-to-point data communication to multiple subscriber equipment.

Applicant respectfully submits that Murren et al may teach data communication, but does not teach use of "multicast communication transport layer" to facilitate a one-to-many delivery of documents. Applicant's claimed invention overcomes bottlenecks associated with communications of data without the use of a multicast communications transport layer. User subscription, however, is managed over typical point-to-point data communications, which is typically the vehicle of bottleneck and delay, which Applicant sought to overcome.

Because Murren et al does not disclose all of the limitations of the amended independent claims 1, 6 and 12, it does not anticipate the Applicant's claims.

Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C.

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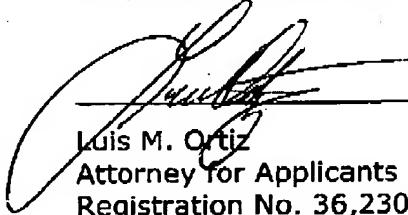
§102(e) rejection of claim 1-13 based on the Murren et al patent publication reference be withdrawn, and the claims as amended be allowed.

III. Conclusion

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention. Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §102 based on the preceding remarks. Reconsideration and allowance of Applicant's claims 1-13 is also respectfully solicited.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,



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